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AUG 31 2010

OFFICE OF PETITIONS

In re Application of Jernstrom :
Application No. 09/508,129 :
Filing Date: March 7, 2000 :
Attorney Docket No. PAT121USA :

Decision on Pétition

This is a decision on the petition under 37 CFR 1.181 filed March 12, 2010, requesting the Office withdraw the holding of abandonment.

The petition is **granted**.

Facts

The application became abandoned on November 8, 2001, as a result of a failure by petitioner to file a reply to a non-final Office action mailed August 7, 2001.

A petition under 37 CFR 1.137(b) and an amendment were filed July 9, 2002. The Office mailed a decision granting the petition on July 25, 2002.

As recognized in MPEP 711.03(c)(II)(A)(2),

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be bona fide. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

The Office mailed a "Response to Amendment" on December 29, 2004. The response indicated the July 9, 2002 amendment was not responsive and gave petitioner the longer of 1 month or 30 days to respond.

An amendment was filed January 6, 2005.

The Office mailed a Notice of Abandonment on March 2, 2006. The notice indicated the application was abandoned due to a failure to reply to the Office letter mailed March 20, 2005.

A copy of a letter mailed March 20, 2005, cannot be located in the image file wrapper for the application and Office computer records (PALM) do not indicate any correspondence was mailed for the instant action on March 20, 2005.

Office PALM records contain the following entry for November 1, 2005: "Mail Notice of Informal or Non-Responsive Amendment." However, the image wrapper for the application does not contain a copy of any correspondence mailed November 1, 2005.

On April 13, 2006, the attorney of record, Joel Skinner, contacted the examiner by telephone and informed the examiner that Skinner had never received the March 20, 2005 correspondence.

Petitioner filed a Status Inquiry on April 18, 2007.

Petitioner filed a Status Inquiry on March 10, 2010.

Petitioner filed the instant petition to withdraw the holding of abandonment on March 12, 2010.

Discussion

Petitioner states the alleged March 20, 2005 correspondence was never received at the address of record. Petitioner states a search of the file jacket and docket records has been conducted and the search confirms the correspondence was not received. Petitioner has not supplied a copy of any docket records.

If the Office mailed correspondence on March 20, 2005, and normal procedures had been followed when mailing the correspondence, the image file wrapper would include a copy of the correspondence and PALM would indicate correspondence was mailed March 20, 2005. In this case, a copy of the correspondence mailed March 20, 2005, cannot be located in the image file wrapper for the application and PALM fails to indicate any correspondence was mailed for the instant action on March 20, 2005. These facts imply a notice may well not have been mailed on March 20, 2005. In addition, in the absence of a copy of the alleged notice in the image file wrapper, the Office is unable to review the content of the correspondence or verify the proper mailing address was listed on the correspondence.

PALM states a Notice of Informal or Non-Responsive Amendment was mailed November 1, 2005. However, the image file wrapper does not contain a copy of the notice and neither the examiner nor petitioner has stated a notice was mailed November 1, 2005. Therefore, the record is insufficient to establish the Office properly mailed a Notice of Informal or Non-Responsive Amendment on November 1, 2005.

The petition to withdraw the holding of abandonment is granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

A terminal disclaimer was filed with the petition. However, the terminal disclaimer is unnecessary. Therefore, the terminal disclaimer has not been accepted.

Although the instant petition is granted, the decision is based on the specific facts in this case. Petitioner may wish to ensure any future petition to withdraw the holding of abandonment based on non-receipt of an Office notice or office action fully complies with the requirements set forth in MPEP 711.03(c)(I)(A).

Technology Center Art Unit 3635 will be informed of the instant decision and will review the amendment filed January 6, 2005. If the examiner determines the amendment is not fully responsive to the prior Office action, the examiner should send a letter pursuant to 37 CFR 1.135(c) giving applicant the longer of 1 month or 30 days to file a paper correcting any error or omission identified by the examiner in the letter. If applicant does not correct the error or omission within the time period set in the letter (including any extension), the application will become abandoned.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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Office of Petitions